

RESPONSE UNDER 37 C.F.R. § 1.116
U.S. Application No.: 10/642,576



Attorney Docket Q77065

REMARKS

Claims 1-8 are rejected under 35 U.S.C. § 103(a) as allegedly being obvious over Momota et al. (U.S. Pat. No. 6,743,562 B2) in view of Tan et al. (U.S. Pat. No. 6,740,470 B2).

In the Response filed December 20, 2004, Applicants submitted a verified English translation of their priority document to obtain the benefit of their priority claim. Applicants' priority date of August 22, 2002 is prior to the November 21, 2002 and April 24, 2003 § 102(a) dates of the Momota et al. and Tan et al. patents, respectively. Accordingly, the Momota et al. and Tan et al. patents are not § 102(a) prior art against the present claims.

Additionally, as set forth in 35 U.S.C. § 103(c), subject matter developed by another person, which qualifies as prior art only under subsections (e), (f), and (g) of section 102, shall not preclude patentability under section 103 where the prior art subject matter and the claimed invention were, at the time the invention was made, subject to an obligation of assignment to the same person. To remove Momota et al. and Tan et al. as § 102(e) prior art for purposes of the § 103 rejection, Applicants stated -- and now re-state -- that the present invention and Momota et al. and Tan et al. were owned by the same assignee, Fuji Photo Film, Co., Ltd., at the time the present invention was made. Therefore, Momota et al. and Tan et al. are not § 102(e) prior art for purposes of this § 103(a) rejection. See page 4 of the Response filed December 20, 2004. Since none of the cited references are proper prior art, Applicants submit that the rejection should be withdrawn.

The Office appears to have overlooked this statement of common ownership in the previous Response. The Examiner is respectfully requested to consider the statement of common ownership, which overcomes the rejection.

While unnecessary, Applicant now turns to the merits of the rejection. Applicant submits that the present invention is non-obvious over the combination of Tan et al. and Momota et al.

The description of Tan et al. in col. 48, lines 30 to 57 (including a) to i)), enumerates resins and photo-acid generators, but no specific examples are set forth. In particular, the acid-decomposable protective group mentioned in Tan et al. includes such ordinary structures which decompose by the action of acid, as set forth in organic chemistry textbooks. Moreover, Momota et al. discloses no specific example for the fluorine-containing resin, though it discloses some resin structures.

The present invention is directed to providing a positive photosensitive composition which is effective in diminishing development defects. Tan et al. is directed to improving the uniformity of a photosensitive layer used for printing plates. The properties relating to development defects cannot be improved by improving coating uniformity which accompanies no sensitivity fluctuation. In addition, the phenomena relevant to the object of the present invention are completely different from those associated with post-exposure delay (PED) and the depth of focus (DOF) set forth in Momota et al.

For a printing plate to function properly, it is necessary that an organic matter (ink) adhere to the residual portion of the photosensitive layer. However, in the case of a photoresist, adhesion of an organic matter (development residue) on the residual portion of the photosensitive layer causes development defects.

Accordingly, Applicant respectfully submits that there is no motivation for one of ordinary skill in the art to combine Tan et al. and Momota et al. for the purpose of reducing developing defects.

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In view of the foregoing, Applicant respectfully submits that the present invention is not obvious over the cited references and that the rejection should be withdrawn.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

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CUSTOMER NUMBER

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